

REMARKS

Claims 1-13 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejections in view of the remarks contained herein.

REJECTION UNDER 35 U.S.C. § 103

Claims 1-13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Brewer in view of Wassink (U.S. Pat. No. 5,633,940). This rejection is respectfully traversed.

Claim 1 includes both incrementally reducing the first parameter before the second parameter in the event of clipping and incrementally recovering an original level of the second parameter before incrementally recovering an original level of the first parameter. This combination of elements is not taught or suggested by Brewer and Wassink either alone or in combination.

The Office Action recognized that Brewer does not disclose recovering a first parameter after a second parameter is fully recovered. (Office Action, Page 4.) The Office Action asserts that Wassink mentions different orders of affecting parameter settings, and the combination of Brewer and Wassink is obvious. However, neither Wassink nor Brewer disclose or suggest that the claimed order would be in any way beneficial.

According to M.P.E.P. § 2143.01, “[t]he mere fact that references can be . . . modified does not render the resultant combination obvious unless the prior art also suggests the desirability of [such modification].” In re Mills, 916 F.2d 680, 16 U.S.P.Q.2d

1430 (Fed. Cir. 1990). That one of skill in the art has the capabilities to arrive at the invention is not the test for whether one of skill in the art would have arrived at the invention based on the teachings of the prior art. *Ex parte Levengood*, 28 U.S.P.Q.2d 1300, 1301-02 (Bd. Pat. App. & Inter. 1993) (“That which is within the capabilities of one skilled in the art is not synonymous with obviousness”). It is improper to use the inventor’s disclosure as an instruction book on how to reconstruct the prior art. *Panduit Corp. v. Dennison Mfg. Co.*, 1 USPQ2d 1593 (Fed. Cir. 1987). Both the suggestion and the expectation of success must be founded in the prior art and not in Applicant’s disclosure. *In re Farrell*, 7 USPQ2d 1673 (Fed. Cir. 1988) (emphasis added.).

As best understood by the Applicants, the Office Action asserts that it would have been obvious to modify the audio distortion processing system of Brewer by providing parameter recovery in reverse order to provide maximum audio output and to avoid output signal distortion.

However, obviousness must be determined at the time that the invention was made. 35 U.S.C. §103. The relevant prior art that should be considered is only that which he or she would have selected without the advantage of hindsight or knowledge of the invention. *Union Carbide Corp. v. American Can Co.*, 220 USPQ 584 (Fed. Circ. 1984).

The combination of Claim 1 primarily reduces noticability or perceptibility of audio distortion reduction processes for listeners by initially reducing narrowband gain and then by initially recovering wideband gain. (Paragraph [0021].) In contrast, Brewer is directed to a system for improving sound quality by merely reducing clipping in an audio spectrum, as is common in the art. Brewer does not appear to contemplate initial

recovery of wideband gain. Further, Wassink is directed to a system *increasing perceivability* of volume adjustment. (Column 1, Lines 44-47.) Wassink is not directed to *reducing* noticability of audio distortion. Therefore it is unclear as to why one of ordinary skill in the art would combine the references as proposed. It is therefore respectfully submitted that the Patent Office has not made a legally sufficient showing of a motivation to combine based on actual, specific, evidence.

Since the Patent Office has offered no proper support or motivation for combining the references other than an unsupported assertion that the combination would be beneficial, it is respectfully submitted that the rejection based on obviousness is clearly and unequivocally founded upon "knowledge gleaned only from applicant's disclosure." M.P.E.P. § 2145. Consequently, it is respectfully submitted that the rejection entails hindsight and is, therefore, improper.

Claim 1 is believed to be allowable for at least these reasons. Claim 8 is believed to be allowable for at least similar reasons as Claim 1. Claims 2-7 and 9-13 depend from Claims 1 and 8 and are believed to be allowable for at least this reason.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicant therefore respectfully requests that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (248) 944-6526.

Respectfully submitted,

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